

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
June 8, 2005

Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Industria Colombiana de Café S.A.
v.
Hena, Inc.

Opposition No. 91125510
to application Serial No. 76286429
filed on July 16, 2001

Helen Hill Minsker of Banner & Witcoff, Ltd. for Industria Colombiana de Café S.A.

Christopher D. Latham of Brecher, Fishman, Pasternack, Popish, Feit, Heller & Reiff, P.C. for Hena, Inc.

Before Seeherman, Grendel and Zervas, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant, Hena, Inc., seeks registration on the Principal Register of the mark CALCAFE in the special form depicted below



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for goods identified in the application as "coffee."¹

Opposer, Industria Colombiana de Café S.A., has opposed registration on the ground that applicant's mark, as applied to the goods identified in the application, so resembles the mark COLCAFE, previously used and registered by opposer for coffee products, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer by which it denied the salient allegations of the notice of opposition. Opposer presented testimony and other evidence at trial, but applicant did not. The parties have fully briefed the case, but no oral hearing was requested. We sustain the opposition.

Opposer has made of record status and title copies of its two pleaded registrations. The first is Registration No. 1509456, of the mark COLCAFE (in standard character form) for "instant coffee."² The second is Registration No. 2057801, of the mark COLCAFE (in standard character form) for "ground coffee and roasted coffee beans."³ Because

¹ Serial No. 76286429, filed July 16, 2001. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a).

² Issued October 18, 1988. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

³ Issued April 29, 1997. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

these registrations are extant and owned by opposer, we find that opposer has standing to oppose registration of applicant's mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 195 (CCPA 1982). Furthermore, because opposer's registrations are of record, priority of use under Section 2(d) is not an issue in this proceeding. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). The evidence of record pertaining to the *du Pont* factors supports the following findings.

Applicant's goods as identified in the application, i.e., "coffee," encompass and therefore are legally identical to the goods identified in opposer's registrations, i.e., "instant coffee" and "ground coffee and roasted coffee beans." Absent any restrictions in the

identifications of goods in applicant's application and opposer's registrations, we find that the parties' goods are marketed in the same, overlapping trade channels and to the same classes of purchasers. The parties' goods are ordinary consumer items which are purchased without undue deliberation or care by purchasers. The evidence of record does not support a finding that opposer's mark is famous in the United States.⁴ There is no evidence of any use by third parties of similar marks on similar goods. There is no evidence of actual confusion, but also no evidence of any opportunity for actual confusion to have occurred.

We turn now to the first *du Pont* factor, i.e., "the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression." The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

⁴ Opposer's witness testified that opposer has made "several million dollars" in sales in the United States since 1979.

Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases such as this, where the applicant's goods are identical to the opposer's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applying these principles in the present case, we find, initially, that the dominant feature in the commercial impression created by applicant's mark is the literal portion of the mark, i.e., CALCAFE. The design features of applicant's mark are not insignificant (especially the squatting man, and the coffee bean to a lesser extent), but they nonetheless are subordinate to the wording in the mark's commercial impression. It is the literal portion of the mark that will be used by purchasers in recollecting the marks and purchasing the goods. *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553 (TTAB 1987).

In terms of appearance, we find that the parties' marks are dissimilar to the extent that applicant's mark includes the design features and opposer's mark does not. However, the marks look similar in terms of their wording, differing only by one letter. Overall, we find that marks to be more similar than dissimilar in terms of appearance.

Phonetically, we find that the marks are highly similar. The design features of applicant's marks would not be pronounced by purchasers, and the literal portions of the marks, COLCAFE and CALCAFE, are very similar. They differ by one vowel, but even those different vowels could be pronounced similarly. There is no "correct" pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. See, e.g., *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461 (TTAB 1985). In their entirety the marks would be or could be pronounced very similarly.

In terms of connotation, we find that the marks are similar to the extent that they both end in CAFE, which connotes "coffee." Viewing the marks in their entirety, we cannot find that purchasers are likely to ascribe different connotations to the marks because of the difference in the letters O and A in the first syllables of the respective marks.

In terms of overall commercial impression, we find that the similarities between the marks, especially the phonetic similarity, outweigh any points of dissimilarity. And, as noted above, because the marks are used on legally identical goods, the degree of similarity between the marks which is necessary to support a finding of likelihood of confusion is less than it would be if the marks were to be used on disparate goods. *Century 21 Real Estate Corp. v. Century Life of America, supra*. We find that the marks are sufficiently similar that confusion is likely to result if they are used on legally identical goods.

Considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we find that a likelihood of confusion exists. We have considered applicant's arguments to the contrary but are not persuaded.

Decision: The opposition is sustained.